

1/16/02

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Paper No. 15
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Wakunaga of America Co. Ltd.

Serial No. 75/256,050

Mario A. Martella of Beehler & Pravitt for Wakunaga of America Co. Ltd.

Joyce A. Ward, Trademark Examining Attorney, Law Office 105 (Thomas Howell, Managing Attorney).

Before Cissel, Hohein and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On March 11, 1997, applicant filed the above-identified application to register "AGED GARLIC EXTRACT" on the Principal Register for "specially processed garlic in liquid and powder form, namely for use as a food supplement and a vitamin," in Class 5. The basis for filing the application was applicant's claim of use of the mark in commerce in connection with the specified goods since December 7, 1990.

The specimen of use submitted by applicant with the application has filed it is a label for a container of Kyolic® dietary supplement. The label notes that applicant's garlic cloves "undergo a unique aging process." Under the heading of "INGREDIENTS," and the label lists "Aged Garlic Extract Powder, Whey, and Magnesium Stearate." An asterisk next to the term applicant seeks to register indicates that "Aged Garlic Extract" refers to a "SPECIAL GARLIC PREPARATION."

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052 (e)(1), on the ground that the term applicant and seeks to register is merely descriptive of the goods identified in the application. In addition, she noted that the term applicant seeks to register appears to be generic as applied to these goods, and advised applicant that under those circumstances, she could not recommend that the application be amended to seek registration on the Principal Register under the provisions of Section 2(f) of the Act or on the Supplemental Register.

Applicant responded to the refusal to register by arguing that its use since 1990 established distinctiveness, and that the Examining Attorney had not met her burden of proof in establishing that the term is

generic in connection with the goods specified in the application. Applicant did not, however, amend the application to seek registration under the provisions of Section 2(f) of the Act.

The Examining Attorney was not persuaded by the arguments presented by applicant in response to the refusal to register. In her second Office Action, she repeated and made final the refusal to register under Section 2(e)(1) of the Act on the ground that the term sought to be registered is merely descriptive of the goods specified in the application. In support of the refusal, she submitted dictionary definitions of the component words which are combined to form the term applicant seeks to register. Citing entries from The American Heritage Dictionary of the English Language, Third Edition, 1992, Houghton Mifflin Co., she noted that "aged" was defined as "to cause to mature or ripen under controlled conditions"; that "garlic" was identified as "an onionlike plant (*Allium sativum*) of southern Europe having a bulb that breaks up into separable cloves with a strong, distinctive odor and flavor The bulb of this plant"; and that "extract" as "a concentrated preparation of the essential constituents of a food, a flavoring, or another substance; a concentrate." She stated that

"[b]ased on the applicant's description of the goods and the information contained on the applicant's product literature[,] the Examining Attorney must conclude that the primary ingredient of the applicant's supplements is a concentrate of garlic, *allium sativum*, which has been matured under controlled conditions. In other words, the primary ingredient of applicant's goods is AGED GARLIC EXTRACT. The wording comprising the applicant's mark is literally the generic name of an ingredient of the goods."

In addition to the dictionary definitions and plain meaning of the words which are combined to form term applicant seeks to register, the Examining Attorney submitted copies of pages from a Web site featuring information provided by a van door of applicant's Kyolic brand nutritional products, and as well as copies of pages from applicant's own website. This evidence shows many examples of how applicants and that other entity use the term "aged garlic extract." The following are typical examples, taken from just five of the many pages submitted by the examining attorney:

Each to garlic extract is a form of garlic produced from a unique aging process... the garlic used in each to garlic extract is also originally grown... studies have suggested that supplementing once diet with aged garlic extract may be beneficial. Some promising data includes reports that aged garlic extract: may afford protection against...

Various studies have suggested that aged garlic extract and its active compounds may inhibit the synthesis of fatty acids and cholesterol...

Various cell culture studies have suggested that aged garlic extract and its constituents may inhibit the growth of human breast cancer cells... that a possible anti-carcinogenic effects of aged garlic extract and its constituents may be due to their ability to reduce the rate of activation of chemical carcinogens...

Studies have also suggested that aged garlic extract may be a promising adjuvant to cancer therapy...

Each garlic extract has been and is still being extensively researched by the National Cancer Institute.

Studies have suggested that aged garlic extract mitigates infectious diseases through enhancement of the immune system. Specifically, aged garlic extract appears to enhance natural killer cell activity... aged garlic extract was also found to minimize the immunosuppression induced by UVB radiation... aged garlic extract was found to enhance the preventive effect of an influenza vaccine... aged garlic extract and its constituents may inhibit the growth of *Candida albicans*...

Each garlic extract and its active compounds may protect the liver from toxicity... aged garlic extract may help to protect the body from heavy metal poisoning... When each garlic extract was combined with red blood cells it prevented lead, Mercury and aluminum from destroying them. When no aged garlic extract was added to the blood samples, these heavy metals ruptured the red blood cells.

Several studies have suggested that aged garlic extract, in conjunction with other nutritional factors, may help to alleviate fatigue and various complaints from athletes and those with colds or various internal diseases. Each garlic extract provides nutrients and a protein fraction, which may be conducive to the growth of the beneficial bacteria

It has also been suggested that aged garlic extract may possess an anti-rancidity ability... each garlic extract may protect lymphocytes ... the garlic extract may protect liver microsomal membranes... aged

garlic extract may also be responsible for its cardioprotective effect against the anti-carcinogenic drug.

Aged garlic extract may ameliorate learning behaviors... aged garlic extract was found to delay the manifestation of learning and memory impairments... because H. garlic extract has demonstrated antioxidant protective effects... a garlic extract restrained the aging speed... in each garlic extract also prolong the survival and enhanced the branching of cultured neurons...

Under the heading of "REDENT DISCOVERIES ON AGED GARLIC EXTRACT," applicant's website notes that

Aged garlic extract has been presented at an array of scientific meetings. Most recently, each garlic extract was presented... studies presented suggested that age garlic extract could decrease the formation of notrosamines... each garlic extract was presented at...

Under the heading of "SAFETY OF AGED GARLIC EXTRACT," applicant's website stated that

The safety of aged garlic extract has been well established by several preclinical and clinical toxicity tests... each to garlic extract is almost without toxicity... tests have all confirmed the safety of aged garlic extract.

As a result of the natural aging process, Kyolic, one of the most scientifically researched garlic supplements, has little in common with the other two types of garlic products. Kyolic is a special aged garlic extract rather than any commercial food additive or flavor in. As a natural plant extract it contains the nutritional benefits of the plant, only in a more concentrated for. Kyolic is organic playground and aged naturally.

Kyolic illuminates the odor through natural aging and is the only truly odor was garlic product available today.

On the last day of the six-month period for its response, applicants filed both a Notice of Appeal and a Request for Suspension and Remand of the application, which was accompanied by additional evidence applicants asserted demonstrates that the term it seeks to register is not merely descriptive, much less generic.

Included in this submission were copies of pages from a 1963 dictionary listing meanings for the individual words which make up the term sought to be registered. These meanings are different from the ones provided by the Examining Attorney from the 1992 dictionary she used. They show, for example, a bad "aged" can be used as a verb form meaning "to grow older," and as an adjective meaning "well advanced to reduction of a basic level-use of topographical features." Applicant argued that the evidence submitted by the examining attorney is somehow not probative because applicant began using the combined term "AGED GARLIC EXTRACT" two years before the dictionary used by the examining attorney was published, and that, in any event, the additional meanings shown in the additional dictionary excerpts submitted by applicant show that the term is

"totally non-descriptive of anything," much less a generic term for applicant's products.

Applicant also submitted additional pages from its own homepage and the homepage of its vendor, and as well as partial results of various computer searches showing "aged garlic extract" used in connection with products made by applicant. Applicant argued that when the term is used, and is only in reference to applicant's goods.

The Board instituted the appeal, but suspended action on it and remanded the application to the Examining Attorney for reconsideration in light of the additional evidence and arguments provided by applicant.

The examining attorney issued an office action stating that consideration of the additional arguments and evidence did not convince her to withdraw the refusal to register, and the application was returned to the board for resumption of action on the appeal. Applicant filed a brief and the examining attorney filed a responsive brief.

Applicant file their applied brief, asserting, among other things, that the brief of the examining attorney was not timely filed, and that the Board should not consider it.

At the outset, we deny applicants requested to disregard the examining attorney's brief. Contrary to

applicants contention, the brief in question was timely filed. The Board sent applicants brief to the examining attorney on May 18, 2001. Trademark rule to. In 142 (D.) provides that the examining attorney has 60 days after applicants brief is said to her to respond. In the instant case, the examining attorney mailed her brief on July 17, 2001, exactly 60 days after she was sent applicants brief. She clearly complied with the rule.

Turning, then, to the merits of this appeal, we note that THE ONLY ISSUE BEFORE THE BOARD IS WHETHER "AGED GARLIC EXTRACT" is merely descriptive of "specially processed garlic in liquid and powder form, mainly for use as a food supplement and a vitamin." As noted above, an applicant never amended the application to seek registration on the Supplemental Register or on the Principal Register under the provisions of Section 32(f). even if applicant had made either such amendment, on this record, registration would plainly not be justified.

The test for mere descriptiveness under section 2(e)(1) of the Lanham acted as well settled. The term is merely descriptive of the goods with which it is used if it immediately and forth with conveys information about a significant ingredient, quality, characteristic, feature,

function, purpose or use of the goods. In re Bright-Crest, Ltd., 2001 USPQ 591 (TTAB 1979).

"AGED GARLIC EXTRACT" he is merely descriptive of the goods identified in the application because the term is the name of the main ingredient of applicants goods. As the specimen label indicates, applicants goods are capsules combining aged garlic extract, whey and magnesium stearate. And although the product does contain of these two other substances, it is nonetheless referred to as "aged garlic extract."

The record makes it abundantly clear that the term is used as the name of the substance, which is used as a dietary supplement. No imagination is required in order to understand the nature of the goods from consideration of the term in connection with the goods. No incongruity or double entendre and he's created by combining the descriptive words which together make up the term. That different meanings would be ascribed to the words which make up this term in other circumstances is not determinative of the issue before us in this appeal, which Is whether the term is merely descriptive in connection with the goods specified in the application.

The fact that the sources of the examples of highly descriptive or generic use of this combined term or

applicant itself and applicants vendor does not alter this conclusion. As the examining attorney points out in her brief, and the term would still be considered merely descriptive even if applicants were the only one to use it descriptive lake in connection with the specified goods. National Shooting Sports Foundation, Inc., 219 USPQ 1018 (TTAB 1983).

The evidence of record shows that "AGED GARLIC EXTRACT" is the name of the primary ingredient of applicants product. As such, it is incapable of acquiring distinctiveness in connection with that substance. The examining attorney was correct in advising applicants that amendment to the supplemental register or claiming registrability on the principal register under section Add to (asset) of the Act would be improper. In under these circumstances, a mere claim of five years of exclusive use could hardly constitute an acceptable showing that this term functions as an indication of the source of applicants dietary supplement, rather than as the name of the primary ingredient of it.

Decision: The refusal to register is affirmed.

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